UNITED STATES
PATENT AND
TRADEMARK OFFICE

1; 98-018-1

General Counsel
Washington, DC 20231
www.uspto.gov

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General Services Administration
FAR Secretariat (MVP)
Attention: Ms. Laurie Duarte
1800 F Street, N.W., Room 4035
Washington, D.C. 20405

Re: FAR Case 1998-018

Dear Ms. Duarte:

The following are the comments of the United States Patent and Trademark Office ("USPTO") regarding a proposal to amend the Federal Acquisition Regulation to provide guidance on the use of names, symbols, and logos that describe government products, services, systems and programs. This proposal was published in the Federal Register on August 9, 2001 (Fed. Reg. Vol. 66, No. 154).

(1) Section 27.X02(a). This section defines trademarks as "generally distinctive symbols, pictures, or words that distinguish and identify the origin of products." This definition is not entirely consistent with statutory understandings of what constitutes a trademark. For example, 15 U.S.C. § 1052 provides that subject to certain exceptions, the USPTO cannot refuse to register "trademark[s] by which the goods . . . may be distinguished from the goods of others." Moreover, a trademark need not be inherently distinctive: rights can exist in a trademark that is not inherently distinctive but that has acquired distinctiveness through use. The USPTO therefore suggests replacing the definition of trademarks set forth in proposed Section 27.X02(a) with the following:

> "Trademarks are, in general, symbols, pictures or words that distinguish and identify the origin of the goods or services of one entity from the goods or services of another entity."

(2) Section 27.X02(b). This section states in part that "[t]he owner of a trademark has exclusive rights to use it on the product it was intended to identify and often on related products." It is not entirely clear to us what this statement means to convey. As a statement of general trademark law, it is slightly inaccurate. Rights in a trademark or service mark do not arise merely because the owner of the mark intended that the mark identify the source of a product or service, but rather arise if the mark actually functions as a source indicator. At the same time, a mark owner may gain the right to exclude others from using a mark for products or services for which it has not itself established its own rights to use. The USPTO therefore suggests amending proposed Section 27.X02(b) by replacing the language of that section with the following:

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"The trademark or service mark owner has the exclusive right to use the trademark or service mark on goods or services for which the mark serves as an indicator of source, and often gains rights to exclude others from using the mark on related products or services as well."

(3) 27.X04(a). This section includes a reference to the "Trademark Act." The USPTO suggests amending this section to include the citation to the Trademark Act as follows: "The Trademark Act of 1946, as Amended 15 U.S.C. *et seq.*"

If you have any questions regarding the USPTO's comments, please call me at 703-308-2000.

Sincerely,

James Toupin
General Counsel
United States Patent and Trademark Office